

III. Remarks

Claims 1-22 are rejected and pending. With this Paper, the Applicants have cancelled claims 8 and 12-22 accordingly. Additionally, two sheets of corrected drawings are attached herewith as explained above. With the amendments and remarks provided herewith, the Applicants respectfully request reconsideration and a withdrawal of all objections and rejections.

Objections to the Specification

Responsive to the objections to the specification on page 3 of the Office action, claims 8 and 18 have been cancelled. No further discussion is necessary. Thus, the Applicants respectfully request reconsideration and withdrawal of all objections to the specification.

Claim Rejections – 35 U.S.C. § 112

Responsive to the rejections of claims 8 and 18 under 35 U.S.C. §§ 103 and 112, claims 8 and 18 have been canceled. Thus, no further discussion is necessary.

Claim Rejections – 35 U.S.C. § 102

Responsive to the rejections of claim 1 under 35 U.S.C. § 102(e) as being anticipated by *Tsuei* (U.S. Patent No. 6,654,779), *Tsuei* does not teach each and every element as recited in claim 1 of the present application. For example, claim 1 recites a step of "sensing a subsequent email address of a subsequent email message to be sent from a second client of the first system." Claim 1 of the present invention senses prior to the message being sent. *Tsuei* fails to teach such limitation. Rather, *Tsuei* teaches that a sender composes a message and then sends the message to a computer system that provides internet access.

Starting in Figure 4 at step 405, a sender composes a message at his or her computer and addresses it to the address believed to be correct for an intended recipient. The sender then sends the message from his computer to a computer system that provides internet access, which is typically the ISP at which the sender maintains an internet service subscription.

Tsuei col. 9, ll. 4-10; see Figure 4 (emphasis added). *Tsuei* clearly does not teach sensing the subsequent email address prior to the message being sent as recited in claim 1 of the present application.

Additionally, claim 1 of the present application recites that the email historical database is "in communication with the first system via a communication network." Contrarily, *Tsuei* teaches an email address management system (EAMS) 330 that is connected directly to the internet 130 (see Figure 3), and not to a user system, and thus is accessible by any ISP that is connected to the Internet and can send and receive email messages. Col. 6, ll. 45-47; see also Figure 3 of *Tsuei*. Clearly, *Tsuei* does not teach each and every element recited in claim 1 of the present application. Therefore, claim 1 is allowable.

Claims 2-11 depend generally from claim 1. Thus, claims 2-11 are allowable for the reasons provided above.

As mentioned above, claims 8 and 12-22 have been cancelled. Thus, no further discussion is necessary.

Claim Rejections – 35 U.S.C. § 103

Responsive to the rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Tsuei*, *Tsuei* does not teach or suggest each and every element as recited in claim 4. Moreover, *Tsuei* does not provide motivation to requesting authorization from the second client to search in the email historical database to determine if the subsequent email address is the old email address of the first client as recited in claim 4. Furthermore, claim 4 is dependent on claim 1. As stated above, *Tsuei* does not teach or suggest all of the elements of claim 1.

Claim 14 has been cancelled. Thus, no further discussion is necessary.

Responsive to the rejections of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over the combination of *Tsuei* in view of *Sommerer* (U.S. Patent No. 6,694,353), the combination does not teach or suggest all the elements of claim 9. Claim 9 is a dependant claim which depends generally from claim 1. As stated above, *Tsuei* does not teach or suggest all of the elements of claim 1 and *Sommerer*

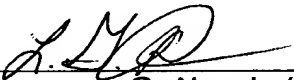
does not teach or suggest elements to cure *Tsuei's* deficiencies. In addition, there is no suggestion or motivation to combine *Tsuei* and *Sommerer*.

Claim 19 has been cancelled. Thus, no further discussion is necessary.

Therefore, claims 1-11 are in a condition for allowance and such action is earnestly solicited.

Respectfully submitted,

December 28, 2004
Date



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Attachment: Replacement Drawings Sheets (2 sheets total)

II. Amendments to the Drawings

Responsive to the objections to Figures 1 and 4 on page 2 of the Office action, it is unclear as to the grounds for the objections. The Applicants have verified that the margins for Figures 1 and 4 are compliant with 37 C.F.R. 121. The Applicants respectfully request that the Examiner provide clarifications as to the grounds for the objections such that appropriate corrections may be made to the drawings as required. However, for the Examiner's review, the Applicants have provided Replacement Sheets for Figures 1 and 4 with labels as believed to have been originally filed. Thus, the Applicants respectfully request reconsideration and a withdrawal of the objections to the drawings.